

### Remarks

Firstly, the Applicants wish to clarify the situation with regard to the previously allowed claims.

The applicants repeat that in the Final Action dated 12/29/2005, the Examiner states that “Applicant’s request for reconsideration of the finality of the last Office Action is persuasive and, therefore, the finality of that action is withdrawn”. The applicants did not just “comment” on the finality of the office action. They asked for an explanation as to why the Examiner indicated that they had requested it be withdrawn when they had not. In 2nd response to the office action dated the applicants elected to compromise with the Examiner, be content albeit reluctantly, with the finality of the office action and accept the claims indicated in the final action as allowable. The Examiner is therefore respectfully requested to clarify and specifically comment on this statement because the applicants made no such request in their correspondence dated 12/29/2005. The Examiner did not address this point in the advisory action mailed 04/11/2006.

The applicant’s earlier correspondence merely canceled the claims that the Examiner had previously rejected. In particular, the Office action mailed 11/14/2005 clearly stated that claims 12-22, and 34 -46 were allowable. The applicants fail to understand how a response that merely limits the application to claims that have been indicated as allowable by the Examiner, as claimed in the Advisory Action mailed 04/11/2006, justify a final action when the Examiner has made the objection based on prior art over which the Examiner had previously indicated the claims were allowable. It is respectfully submitted that the procedure adopted by the Examiner is highly irregular and contrary to the provisions of MPEP set forth below. The Examiner is of course within his rights to withdraw his indication of allowability, but when he does so on the basis of an existing reference over which he had previously indicated the claims were allowable, it is submitted that the applicants should have the opportunity to consider the new ground of rejection without threat of final action.

MPEP Section 706(a) reads:

“Under present practice, second or any subsequent actions on the merits shall be final,  
except where the examiner introduces a new ground of rejection that is neither

necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..."(emphasis added)

The Examiner concedes in the office action that the rejection is a new ground of rejection. The rejection cannot have been necessitated by the applicant's amendment since in the correspondence referred to the applicants merely canceled all the claims in the application except those indicated allowable by the Examiner.

Moreover, MPEP 706.04 clearly states the Examiner should point out that the claim was previously allowed using Form Paragraph 7.50. The applicants can find no reference in the office action mailed 12/29/2005. The Examiner appears therefore to have erred on at least two counts in

- 1) wrongly attributing to the applicants a request for withdrawal of the final action, and
- 2) failing to use Form paragraph 7.50.

Moreover 706.04 states:

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

"Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her office action that the claim now being rejected was previously allowed by using Form Paragraph 7.50.

#### ¶ 7.50 Claims Previously Allowed, Now Rejected, New Art

The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]. Rejection(s) based on the newly cited reference(s) follow.

With regard to the formal objection to claim 18, this error, which resulted from an incorrect claim listing, has been corrected.

Claims 12, 19, 34 and 43 have been amended. Claims 47 to 59 have been added. The total claim count has not been exceeded in view of the canceled claims.

Not only, it is respectfully submitted, has the Examiner made the above errors with regard to procedure, it is also respectfully pointed out that the Examiner appears to have made a

significant error in understanding the operation of the applicant's invention with regard to claims 13-22 and 37 -46. As clearly stated in the passage on page 32, lines 13- 20, the order in which the controller selected for release corresponds to the reverse of the order of priority in which they are released. When a group of connections are to be released, higher priority connections are released first. However, when you have a group of connections in a link, and the bandwidth is reduced by a certain amount so that it can no longer carry all the connections, you have to select which ones to release. In this case, the lower priority connections are selected for release first, leaving the higher priority connections to be carried by the portion of the link remaining in good standing. Once a subset of connections have been selected for release, then the connections within this subset are released in the order from the highest priority to the lowest priority. The objection with regard to these claims is therefore respectfully traversed. The Examiner's rejection is apparently based on a misunderstanding of the manner in which the embodiment in these claims operates. Clearly, the prior art does not show reversal of the order of priority.

With regard to the Examiner's new ground rejection of claim 12, which he had previously indicated as allowable, it is respectfully pointed out that Arslan contains no teaching of selecting a group of connections from a number of connections corresponding to a reduction in bandwidth. It is fundamental in patent law that one must not read into a reference a teaching that is not present.

There may be some confusion between the use of the term bandwidth capacity as applied in the context of the present invention and Arslan. The invention defined in claim 12 is primarily, but not exclusively, concerned with IMA where a trunk is made up of a plurality of physical links. For example, if there are ten physical links each carrying 1.544 Mb/s T1), the total bandwidth capacity of the aggregated trunk is 15.44 Mb/s less any overhead. If say, two physical links are lost, the bandwidth capacity of the aggregated trunks falls to 12.352 Mb/s ( $15.44 - 2 \times 1.544$ ). The present invention as defined in claim 12 is concerned with what happens when the physical bandwidth carrying capability of a trunk is reduced. A trunk with less bandwidth carrying capacity is capable of carrying less connections, and therefore some of them must be released. Thus, when claim 12 refers to

a reduction in bandwidth capacity of the trunk, it is not referring to the loss of logical connections, but rather to loss of the ability of the trunk to carry connections.

In the above example, let's say for the sake of argument that the aggregate trunk is carrying 5 logical connections, each carrying 2.1544 Mb/s, and the aggregate trunk loses one of its physical component trunks, it would no longer be able to sustain 5 logical connections, it would only be able to sustain 4. This is the situation that claim 12 envisages. When Arslan refers to the failure of a circuit, he is talking about the failure of some of the connections carried by the trunk, not a reduction in the bandwidth carrying capability of the trunk itself. Claim 12 has been amended to clarify this point by specifying that the claim refers to the carrying capacity of the trunk for the connections. If a connection fails, the ability of the trunk to carry that bandwidth does not fail. Claim 19, which relates specifically to IMA has been amended to make it clear that the carrying capacity is determined by the number of links in the IMA trunk (This follows from the discussion at the top of page 25). In most cases, the invention is concerned with reduction in physical bandwidth, and claim 19, is so limited, but in theory the trunk could be made up of logical connections, but the important point is that the reduction in bandwidth that triggers the priority release mechanism is not caused by a loss of one of the connections carried by the trunk, but rather is caused by a reduction of bandwidth carrying capacity of the trunk, which means that some of the connections have to be released. This is not the same thing.

In the passage referred to by the Examiner at Col. 7, lines 8,9, Arslan merely states that "not all the channels carried over the link need have failed". Firstly, it is not entirely clear what this statement means because the circuits are typically trunks, which each carry a number of channels. At col. 7. line 16, Arslan states that an alarm is triggered if a circuit or a portion of a circuit has failed. This implies if any of the channels within a circuit fail, the entire circuit is restored. It says nothing about channels within a circuit. Secondly, Arslan's statement that some of the channels may fail does not imply a reduction in the bandwidth capacity of the link. The fact that a circuit within a link has failed does not mean that the link is not capable of carrying the circuit. The bandwidth carrying capacity of the link remains the same in the event of channel failure.

In accordance with the invention, when the carrying capacity of the link or trunk is reduced, a decision is made to release a sufficient number of circuits to compensate for the reduction in bandwidth. These circuits have not necessarily failed as taught by Arslan, which cannot be regarded as a teaching of the “upon detection” step of claim 12.

As noted above, with regard to claim 13, the Examiner’s rejection seems to be based on the false premise that the wording of the claim is incorrect. Such rejection is respectfully traversed because clearly the prior art does not teach selecting connections for release based on the lowest priority connection first. The Examiner states in the final action that it would be obvious to select the highest priority connections for release, when in fact it is the lowest priority connections that are selected for release first in the case of a reduction in bandwidth capacity. Having stated that it is obvious to select the highest priority connections for release, apparently based on a misconception of the invention, the applicant’s respectfully submit that it is not now open for the Examiner to assert that it would be obvious to select the lowest priority connections for release, which is in fact much more efficient because the highest priority connections can be maintained for the longest period of time.

Similar arguments apply *mutatis mutandis* to the apparatus claims 34 - 43.

With regard to new claims 47 to 59, these claims reflect many of the limitations of claims 1 to 11 and 23 – 29 that were canceled in response to the office action of 11/14/2005, which indicated that claims 12-22 and 34 – 46 were allowable. However, the new claims are directed to a method and apparatus wherein call release messages propagate outwardly from the entities on either side of the failure (see page 12, line 20) and wherein the source entities initiate re-establishment of the call in the order in which the release messages are received (see page 13, lines 5 and 6).

Hsing discloses a basic ATM network, with which the invention is primarily concerned, and in which the problem solved by the invention arises, namely that connections will be re-established by the source entities in an order that has no regard to their importance. Arslan is concerned with a network, such as an X.25 network, wherein each node is associated with a restoration processor. The only common feature with the present invention is that the circuits are associated with a priority indicator, which is used by the restoration processor to restore the circuits based on their priority. However, there is no

teaching of sending release messages in an order based on this priority indicator, and to say the mere fact that Arslan suggests the use of a priority indicator in the context of his system employing restoration processors is sufficient to establish obviousness in respect of a system wherein the connections are re-established by the source entities in the order in which the connection release messages are achieved is pure hindsight. The motivation for combining references has to be found in the prior art, not in the applicant's teachings. In the absence of any restoration processors in Hsing , which are an integral part of Arslan's teachings, there would be no motivation, based on the teachings of the prior art, to apply such priority indicators to Hsing. Neither reference, either alone or in combination, teaches propagating connection release messages toward the source and destination entities in an order determined by a priority indicator. In order to sustain an obviousness rejection, the prior art has to suggest the invention in its entirety, and this it clearly fails to do.

As explained by the Federal Circuit:

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch* 23 USPQ 2d 1780.

Also, the Federal Circuit has stated:

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some “teaching, suggestion or reason” to combine cited references... When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. *McGuinley v Franklin Sports Inc.* 60 USPQ2d.

It is certainly true that in hindsight, conceptually the present invention is simple. But the truth of the matter is that the prior art does not suggest either alone or in combination sending connection release messages based on priority indicators. It only suggests

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associating priority indicators with connections in a network where connections are restored using restoration processors, and where the restoration processors act accordingly. This has nothing to do with the sending of connection release messages as claimed.

As the Federal circuit noted in *Arkie Lures, Inc. v Gene Larew Tackle, Inc.*, 43 USPQ 2d, “The question is not whether salt “could be used”, as the district court concluded, but whether it was obvious to do so in the light of all the relevant factors”. The question is not whether priority indicators could be employed with connection release messages, but it was obvious to do so when clearly the prior art does not so teach.

In the applicant’s respectful submission, the Examiner has failed to show a proper combination to sustain an obviousness rejection. The Examiner’s alleged combination lies at a high level of abstraction which takes a high concept, the use of priority, from one environment and seeks to apply it to another in the absence of any teaching to do so.

In summary, the Examiner’s initial position prior to his “further consideration” with regard to allowability of the claims 12-22 and 34-46 on file was correct, and furthermore it is respectfully submitted that new claims 47 to 59 are patentable for the reasons set forth.

Accordingly, reconsideration and allowance are respectfully requested.

Respectfully submitted,



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